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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,084	06/24/2004	Hideyuki Tsutsumi	4605-044470	5872

7590

06/30/2006

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,084

Applicant(s)

TSUTSUMI ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/17/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-43 is/are pending in the application.
- 4a) Of the above claim(s) 27-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment of 4/17/06 has been entered. Claims 10-43 are pending.
2. Newly submitted claims 27-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-26, as originally presented and examined, drawn to a resin composition, classified in class 524, subclass 413 plus depending on the particulars of the compositions.
- II. Claims 27-43, drawn to a reflector plate, classified in class 362, subclass 341.

The inventions are independent or distinct, each from the other because:

Inventions of group I and group II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as making any article other than a reflector plate that can be made with resin compositions such as a three dimensional non-plate shaped statue and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants. The composition of group I possesses a random shape which must be processed into a reflector plate by some means which changes the identity of the composition into a reflector plate.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10-26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat.

No. 5849826 Ogo et al..

Ogo discloses the instantly claimed compositions at the abstract, which reads on the instantly claimed semiaromatic polyamides; column 2, lines 19 through column 15, line 25, which further discloses the instantly claimed semiaromatic polyamides; and column 15, lines 28-46, particularly 30-31 which encompasses the instantly claimed amounts of wollastonite and K titanate fibers. The list of the patentee of fibers is so small that the choice of wollastonite of K titanate fibers is anticipated. The endpoints of the ranges of the amounts of the patentee fall within the scope of the amounts of the instant claims and are therefore anticipatory of the claimed amounts.

The compositions of Ogo must necessarily and inherently be capable of making reflectors therefrom because they are the same compositions as recited in the instant claims. The compositions of Ogo must necessarily and inherently possess the light reflectance and

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absorbance properties of the instant claims because they are the same polymers and compositions of the instant claims. The argument that the Ogo does not disclose the instantly claimed mixing ratio of the monomer of the resin composition ignores the clear teachings of Ogo cited above, which clearly encompasses having more than 20 molar percent of aromatic monomers since the acids may be all aromatic which is 50 mole percent aromatic monomers minimally. See, for example, the abstract. Arguments regarding the preamble are not persuasive because the instant claims are directed to the composition per se. The article claims have been withdrawn, as stated above. The applicant does not show that the composition of the patentee is not capable of the claimed intended use. This rejection is maintained for the above stated reasons.

5. Claims 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5849826 Ogo et al..

Ogo discloses the instantly claimed compositions at the abstract, which reads on the instantly claimed semiaromatic polyamides; column 2, lines 19 through column 15, line 25, which further discloses the instantly claimed semiaromatic polyamides; and column 15, lines 28-46, particularly 30-31 which encompasses the instantly claimed amounts of wollastonite and K titanate fibers. The list of the patentee of fibers is so small that the choice of wollastonite of K titanate fibers is anticipated. The endpoints of the ranges of the amounts of the patentee fall within the scope of the amounts of the instant claims and are therefore anticipatory of the claimed amounts.

The compositions of Ogo must necessarily and inherently be capable of making reflectors therefrom because they are the same compositions as recited in the instant claims. The compositions of Ogo must necessarily and inherently possess the light reflectance and

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absorbance properties of the instant claims because they are the same polymers and compositions of the instant claims.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof in the compositions of the patentee because they are encompassed by the patentee so thoroughly that the ordinary skilled artisan would have readily envisioned the instantly claimed invention from the disclosure of the patentee and these combinations of ingredients and amounts thereof would have been expected to give the properties of the compositions of the patentee. The instantly claimed absorbance and reflectance properties are inherent to the materials disclosed by the patentee and would have been expected in the final compositions containing these ingredients. There is no showing of unexpected results stemming from the instantly claimed inventions in a manner commensurate in scope with the instant claims and the cited prior art.

The argument that the Ogo does not disclose the instantly claimed mixing ratio of the monomer of the resin composition ignores the clear teachings of Ogo cited above, which clearly encompasses having more than 20 molar percent of aromatic monomers since the acids may be all aromatic which is 50 mole percent aromatic monomers minimally. See, for example, the abstract. Arguments regarding the preamble are not persuasive because the instant claims are directed to the composition per se. The article claims have been withdrawn, as stated above. The applicant does not show that the composition of the patentee is not capable

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

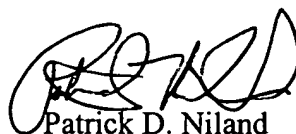
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'PD Niland', is positioned above the printed name.

Patrick D. Niland
Primary Examiner
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